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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/435,461 11/05/99 DYSON

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HM12/0823

EXAMINER

MELLER, M

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

08/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/435,461

Applicant(s)

Dyson et al.

Examiner

Michael Mell r

Group Art Unit

1651

☒ Responsive to communication(s) filed on Jul 10, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the applicat

Of the above, claim(s) 14-16 and 18-20 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 and 17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I, claims 1-13 and 17 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It is also noted that applicant elected *Pseudomonas* for their species election of claim 11 (Chris Stone by telephone on 7/19/2000) as required by the restriction and election of species requirement of paper number 4.

Since the requirement is proper, it is made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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These claims are indefinite since it is not clear what applicant considers to be the "control". This term has no antecedent basis in the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lund et al. (See abstract), JP 05344897 (see abstract), Enomoto et al. (See col. 2, lines 25-66), Petersen (see cols. 1-2), EP 214,761 (see abstract), or EP 476,915 (see abstract and pages 2-3).

Each of the references teach the modification of a polyester with a polyesterase enzyme from *Pseudomonas*. It is deemed inherent that the polyesterase has at least 10-100% greater hydrolysis in a UV and/or a MB assay than a control.

6. Claims 1, 2, 5-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart et al.

The reference teaches the modification of a polyester with a polyesterase enzyme from *Pseudomonas*. It is deemed inherent that the polyesterase has at least 10-100% greater hydrolysis in a UV and/or a MB assay than a control.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund et al. (Lund), JP 05344897 , Enomoto et al. (Enomoto), Petersen , EP 214,761 , or EP 476,915 taken with JP 52082774.

The primary references are discussed above. They do not teach specifically that the polyester they are treating is an aromatic polyester.

JP 52082774 teaches that aromatic polyesters are modified by a lipase from *Pseudomonas*.

It would have been obvious to one of ordinary skill in the art to use an aromatic polyester in the methods of the primary references since as taught by JP 52082774, aromatic polyesters are well known in the art and it is simply the choice of the artisan to use a polyester such as an aromatic one. Further, since the reference teaches that lipases from *Pseudomonas* can modify a polyester, then this provides further motivation to use such a polyester.

Any inquiries concerning this communication should be directed to Examiner Mike Meller at telephone number (703) 308-4230. If attempts to reach the examiner by telephone are

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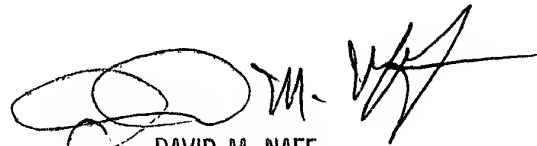
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unsuccessful, the Examiner's supervisor, Michael Wityshyn, can be reached at (703) 308-4743.

The Fax phone number for the art unit is (703) 308- 0294. Any inquiries of a general nature or

relating to the status of this application or proceeding should be directed to the Group

receptionist whose telephone number is (703) 308-0196.



DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651